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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,379	09/26/2006	Beat Michael Aebli	LA/1-23038/A/PCT	2322

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Ciba Corporation
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EXAMINER

VASISTH, VISHAL V

ART UNIT	PAPER NUMBER
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1797

NOTIFICATION DATE	DELIVERY MODE
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01/04/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/594,379	Applicant(s) AEBLI ET AL.	
	Examiner VISHAL VASISTH	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: the transitional phrase in claim 9 reads, “essentially consists of,” wherein the transitional phrase should read, “consists essentially of.” Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

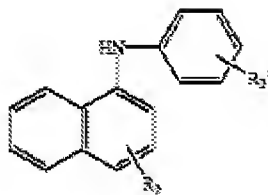
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ribeaud et al., US Patent Application Publication No. 2002/0065201 (hereinafter referred to as Ribeaud).

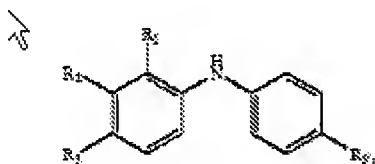
Ribeaud discloses a lubricant composition for hydraulic fluids comprising a base oil of lubricating viscosity (component (B) of claims 1, 2 and functional fluid of claim 6 and hydraulic fluid of claim 7) (Para. [0026]) and adding an additive mixture comprising 5-tert-butyl-4-hydroxy-3-methylphenyl substituted fatty acid esters, diphenylamine antioxidants and zinc dithiophosphates (additives as recited in claim 8) (see Abstract) to said hydraulic fluid (as recited in claim 12) (Claim 8 of Ribeaud).

The diphenylamine antioxidants of Ribeaud can be represented by the following formula:



wherein R_3 is preferably a hydrogen and R_3' is a branched C_{2-30} alkyl such as a branched octyl or nonyl group (component (a) of claims 1, 2 and 9) (Para. [0048]-[0051]).

The diphenylamine antioxidants of Ribeaud can also be represented by the following formula:



wherein R_1 , R_2 and R_3 represent a hydrogen and R_3' is a branched C_{8-18} alkyl such as a branched octyl or nonyl group (component (b) of claims 1, 2 and 9) (Para. [0052]-[0053]).

The diphenyl antioxidants of Ribeaud can be present in the composition as a mixture of two or more compounds defined by the formulae above, wherein the alkyl groups on the phenyl ring differ by their chain length (Para. [0056]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1797

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

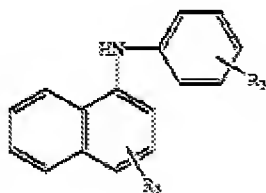
6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ribeaud.

Ribeaud discloses all of the limitations discussed above including alkylated N- α -naphthyl-N-phenylamine and diphenylamine used in combination in a hydraulic fluid.

Ribeaud does not, however, explicitly disclose the alkyl groups being 2,4-dimethyl-2-heptyl, 1-phenylethyl or 2-phenyl-2-propyl for the N- α -naphthyl-N-phenylamine compound.

The N- α -naphthyl-N-phenylamine antioxidants of Ribeaud can be represented by the following formula:



wherein R_3 is preferably a hydrogen and R_3' is a linear or branched C_{2-30} alkyl as

discussed above. It is the position of the examiner that one of ordinary skill in the art

Art Unit: 1797

would envisage the enumerated groups from claims 3-5 from the disclosure of linear or branched C₂₋₃₀ alkyl.

Claim Rejections - 35 USC § 102/103

7. Claims 13-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ribeaud.

Ribeaud discloses all of the limitations discussed above explicitly or in a manner that one of ordinary skill in the art would envisage the instant claims by the disclosure of Ribeaud. It is further the position of the examiner that claims 13-18 are product-by-process claims and therefore a 102/103 rejection is appropriate. 35 U.S.C. 102 and 103 rejections for product-by-process claims are supported by the courts. *"We are therefore of the opinion that when the prior art discloses a product which **reasonably appears to be either identical with or only slightly different than** a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable."* *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

The burden now shifts to applicant in order to overcome the rejection. After a *prima facie* case of unpatentability has been made, the burden is shifted to Applicants. In order to overcome the rejection, applicant needs to show that the claimed process imparts **unexpected** property or structure to the end product that renders the structure product patentably distinct from the prior art's. *Ex parte Gray*, 10 USPQ2d 1922 (BPAI 1989). See also MPEP 2113.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797